

REMARKS/ARGUMENTS

This paper responds to the Restriction Requirement of November 15, 2004 and requests examination of the application. The shortened statutory period runs through December 15, 2004. Accordingly, this response is timely.

In summary, Applicant responds as follows. (a) The Restriction Requirement does not include claim 240 in any group. It should be examined with Group II. (b) Claim 186 has more in common with the independent claims of Group II than with Group I, and should be examined with Group II. (c) Claim 241 (the independent claim of Group III) is obvious over claim 225 (in Group II). Therefore Group III should be examined with Group II.

(d) Applicant elects Groups II and III as modified (claims 186-263), with traverse.

(e) Groups I and IV are misclassified: they are more profitably searchable in the same class and subclass as Group II. Further as a practical matter, a search of Groups II and III will nearly inevitably result in a search of Groups I and IV. Accordingly, all claims should be examined together.

I. The Groups Are Not Properly Divided Because The MPEP Instructs That "No Reasons Exist For Division" Between These Related Groups

When properly classified, all claims may be searched together. Because they are "related," no restriction is warranted.

MPEP § 803 states the requirements for a restriction requirement (emphasis added):

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(1) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - § 806.05(i)) and

(2) There must be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §806.04(a)-(j), §808.01(a) and §808.02).

MPEP § 803 clarifies (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

As shown below, all groups are searchable in the same subclasses. The Restriction Requirement admits that all groups are "related." Therefore, there is no "serious search burden," and no restriction is proper.

A. Group I (claims 287-297): the Classification Proposed in the Restriction Requirement is Incorrect – Group I Should be Searched in 705/35

The Restriction Requirement of July 2004 proposes to classify Group I in class 705, subclass 38. This classification is incorrect for several reasons.

First, as made clear by claims 297 and 298, some of the independent claims in Group I (claims 287 and 294) are generic to "loans and lines of credit" and to "insurance." 705/38, being directed specifically to "loans," is too narrow. Subclass 35 is the most specific class that is generic to both "loans and lines of credit" and to "insurance," and is therefore a more appropriate search class.

Second, 705/38 is directed to "evaluation of the risk factors in a loan determination." These claims do not recite any particular method of such "evaluation." At most, any "evaluation" is merely one component of the overall invention of these claims, and does not of itself cause classification in 705/38. Subclass 35 is directed to "computerized arrangement for planning the disposition or use of funds or securities, or extension of credit," a more accurate characterization of the subject matter of Group I taken as a whole.

Therefore, the subject matter of Group I is searchable in subclass 35, with secondary search classes of 1, 36, and 37.¹ The dependent claims further clarify that subclass 35 is appropriate, and 38 is not.

The relevant class and subclass definitions are as follows:

CLASS 705 DATA PROCESSING: FINANCIAL, BUSINESS PRACTICE, MANAGEMENT, OR COST/PRICE DETERMINATION

SECTION I - CLASS DEFINITION

This is the generic class for apparatus and corresponding methods for performing data processing operations, in which there is a significant change in the data or for performing calculation

¹ This discussion is directed to assisting the Examiner in framing an efficient search, and therefore is intended to direct the Examiner to the place where the best prior art is likely to be. It should be understood that this is not a limiting discussion of the invention or the scope of the claims.

operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.

...

SCOPE OF THE CLASS

1. The arrangements in this class are generally used for problems relating to administration of an organization, commodities or financial transactions.

1 AUTOMATED ELECTRICAL FINANCIAL OR BUSINESS PRACTICE OR MANAGEMENT ARRANGEMENT:

This subclass is indented under the class definition. Subject matter ... in which there is a significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.

(3) Note. The arrangements in this and its indented subclasses are generally used for problems relating to administration of ... financial transactions ...

35 Finance (e.g., banking, investment or credit):

This subclass is indented under subclass 1. Subject matter drawn to a computerized arrangement for planning the disposition or use of funds or securities, or extension of credit.

36 Portfolio selection, planning or analysis:

This subclass is indented under subclass 35. Subject matter drawn to a computerized arrangement for planning the selection or evaluation of securities or other investments for a single entity.

37 Trading, matching, or bidding:

This subclass is indented under subclass 35. Subject matter including the trading or exchange of securities or commodities within an organized system.

B. Group II (claims 187-239 and 252-263): the Classification Proposed in the Restriction Requirement is Incorrect – Group II Should be Searched in 705/35

Many of the claims in Group II, for example claims 187, 213, 221, 222, 228, 229, 237, 241, 242, 253, and 254 refer to activities that typically occur in a primary or origination market. In contrast, subclass 37 relates only to "trading or exchange," which almost always occurs in a secondary market. Subclass 705/35 is the most precise class that is generic to both origination and secondary markets. A search that is limited to subclass 37 will not locate the best prior art.

As noted in point (c) in the Introductory Remarks, claims 225 (from Group III) and 241 (in this Group II) should be searched together. The Restriction Requirement recognizes that claim 225 is best searched in 705/35. Applicant observes that the same analysis applies to the remainder of Group II.

Especially when the dependent claims are considered, it is seen that the subject matter of Group II is best searched in subclass 35, with secondary search classes of 1, 36, and 37.

C. Group IV (claims 264-286): the Classification Proposed in the Restriction Requirement is Incorrect – Group IV Should be Searched in 705/35

The Restriction Requirement of November 2004 proposes to classify Group IV in class 705, subclass 1. Subclass 1 is not totally unreasonable; however, Applicant observes that subclass 35 is more specific and is more correct.

Applicant observes that the statement in the Restriction Requirement, that Group IV is directed to “obtaining information for qualifying a loan applicant,” is not correct. There is no direct recitation in either claim 264 or 282 (the independent claims of Group IV) of “qualifying” the applicant. For example, claim 264 recites “updating the database with information describing the closed financial products; and making the database available to parties on a secondary market for the financial products.” These steps typically occur after qualification has occurred. Further, claims 264 and 282 are generic to “financial products,” not specific to “loans,” as stated in the Restriction Requirement.

In pertinent part, the definition for subclasses 1 and 35 is set forth above at page 26. The claims of Group IV relate to “Finance (e.g., banking, investment or credit),” the subject matter of subclass 35. A search limited to subclass 1 may well miss the most pertinent art. Especially when the dependent claims are considered, it is seen that the subject matter of Group IV is best searched in subclass 35, with secondary search classes of 1, 36, and 37.

D. As Correctly Classified for Search, Groups I, II, III and IV are Properly Examined Together

The Restriction Requirement concedes that all four Groups are “related” (paragraph 5). “Related” groups may not be restricted when they are classified together for search. MPEP

§ 808.02 ("Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions."). Because all claims should be searched in the same search class and subclass (705/35, with secondary searches in 705/1, 36 and 37), no reasons exist for restriction.

Further, Applicant suggests that the search burden between these Groups is unlikely to be "serious" in light of the Office Action of October 2002 that searched all of these claims together, and applied overlapping combinations of references.

In view of the lack of "serious burden," Applicant requests that the Restriction be withdrawn.

II. An Examination of Groups II and III will Nearly Inevitably Involve a Search of Groups I and IV

The elected Groups, Groups II and III, include claims 221, 222, 228, 242, 253, and 254. Unless the independent claims of Groups II and III are allowed in the next Office Action, any examination of Groups II and III will necessarily result in a search of these dependent claims. Once the dependent claims of Groups II and III are searched, a search of at least the independent claims of Groups I and IV nearly "falls out for free." If there is no "serious" search burden, restriction of Groups I and IV from II and III is not warranted.

III. Claim 186 is Misclassified and Should Be Examined With the Elected Group

Applicant observes that claim 186 has more in common with the independent claims of Groups II and III than with Group I. For example, the two paragraphs of claim 187 are recited almost identically, but with somewhat narrower limitations, in the first and second-to-last paragraphs of claim 186. A comparison of the independent claims of Groups II and III (187, 213, 225, 241, 252 and 264) will reveal that they overlap with well over half of claim 186.

Further, consideration of a very few of the dependent claims in Groups II and III (*e.g.*, claims 221, 222, 228, 242, 253, 254) will result in consideration of the remainder of claim 186. This demonstrates that there is no "serious" search burden in searching claim 186 with the elected Groups.

In contrast, claims 287 and 294 (the independent claims of Group I) overlap claim 186 to a much lesser degree.

If any restriction requirement is maintained, claim 186 should be grouped with Groups II and III, rather than with Group I.

IV. Conclusion

All claims are properly examined together.

In the alternative, Applicant requests examination of claims 186-263 (Groups II and III), and rejoinder of Groups I and IV in the event that the limitations of Groups I and IV are searched in the course of examination of Groups II and III.

Should the requirement for restriction be made final, the Examiner is respectfully requested to state on the record that the claims in each group are patentable (novel and nonobvious) over each other.

Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114459-05-E3.

Respectfully submitted,

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